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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/779,978

02/17/2004

Peter M. Bonutti

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08/03/2007

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EXAMINER

DAWSON, GLENN K

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

08/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/779,978

Applicant(s)

BONUTTI ET AL.

Examiner

Glenn K. Dawson

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 6,9,11-13,26-34,47 and 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,10,14-23 and 35-4245 is/are rejected.
- 7) ☒ Claim(s) 24,25,43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02-17-2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Election/Restrictions

Applicant's election with traverse of Group I species IIIA and species of fig. 40-47 in the reply filed on 05-21-2007 is acknowledged. The traversal is on the ground(s) that the apparatus and method claims are not independent and distinct. This is not found persuasive because the MPEP in 802.01 and 802.02 clearly sets forth that restriction is proper between two or more independent or two or more distinct inventions. As outlined in the restriction, the inventions, though related, are in fact distinct for the reasons given before. If applicant would like to state on the record that the method claims are obvious in view of the apparatus claims, then the examiner would consider withdrawing the restriction requirement.

Claims 6,9,11-13,26-3447 and 49-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 05-21-2007.

The claims drawn toward energy being provided through a side portion of the horn is not found in the elected species.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

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of the following is required: the specification does not provide antecedent basis for the sleeve being an "insulation sleeve", nor that the sleeve is biased forward.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,8,10,14-18 and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan-6267761.

Ryan discloses two compression elements 22,20 and an energy source 31. As seen in fig. 1-4 or 15, one element is a tubular element with a fixed compression element and the other is a tubular element slidable inside the outer tube and has a movable compression element. A handle actuator moves one of the compression elements towards the other. Rf energy is applied to the compression elements.

Claims 1,4,5,7,8,10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Egan-6106545.

Egan discloses two compression elements 38,40 and an ultrasonic energy source. One of the compression elements is a horn and the other is an anvil. They can both move relative to each other.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Yates, et al. 5403312.

Yates discloses two compression elements 32,34 and an energy source 60 connected thereto. An insulating sleeve 30 is placed around the compression elements.

Claims 1,2,4,5,7,8,10,14-19,35-38,45 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Winston, et al. 3513848.

Winston discloses a device as shown in fig. 3A having two compression elements 57A and 46A. One is held rigidly to tube 70a and the other is slidably movable inside the outer tube. A spring 82a can bias the horn 57a either towards or away from anvil 46q. A source of ultrasonic power 71a is attached to the device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3,20-22 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winston, et al.-'848 in view of Yates-'312, or Meade-5478351 or Shikhman, et al.-5423796.

Winston discloses the invention as claimed with the exception of the specific compressive force. As Winston discloses that this force varies depending on the suture used, the prior art force applied by the spring being within the claimed range would have been expected to perform the intended function of the tightening of the suture as it would be sufficient to grip the suture and hold it steady during melting. Winston also fails to provide the insulating sleeve. Each of the teaching references disclose that it was known to provide electrosurgical instruments with outer insulating sleeves. It would have been obvious to have provided Winston with such a sleeve, in order to protect the user and the patient from possible burns.

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Claims 21-23,40-42 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winston in view of Shikhman, et al.-'796.

Winston discloses the invention as claimed with the exception of the insulating sleeve. Shikhman discloses that it was known to provide an electrosurgical instrument with an outer insulating trocar sleeves. It would have been obvious to have provided Winston with such a sleeve, in order to protect the user and the patient from possible burns, while providing a sleeve through which the device could be inserted in order to suture internally.

Allowable Subject Matter


Claims 24,25,43,44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K. Dawson whose telephone number is 571-272-4694. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Glenn K Dawson
Primary Examiner
Art Unit 3731

Gkd
30 July 2007